REMARKS

Reexamination and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

As correctly noted in the Office Action Summary, claims 16-23, 27 and 28 were pending.

By the present response, independent claim 23 is amended to recite that the composition is free of polyphenylene ether and to replace "consisting of" with "comprising." New dependent claim 30 recites the subject matter of claim 16 but with a lower limit of electrically conductive filler of 5% by weight.

Thus, upon entry of the present response, claims 16-23, 27 and 28 are pending and await further consideration on the merits.

Support for the amendments can be found in at least the following places in the Specification: Examples 1 and 2, and ¶[0014].

Entry of the amendment is appropriate pursuant to 37 C.F.R. §1.116 in that the amendment raises no new issues. Applicants also respectfully submit that the amendment resolves the outstanding rejections, or, in the alternative, places the claims in better form for appeal.

CLAIM REJECTIONS UNDER 35 U.S.C. §§102/103

Claims 16-23 and 27-28 stand rejected under 35 U.S.C. §102(e) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent Application Publication No. 2003/0134963 to Miyoshi et al. (hereafter "*Miyoshi et al.*") on the grounds set forth in the Official Action. The rejection is respectfully traversed.

ARGUMENTS

Applicants respectfully submit that the reference as applied fails to disclose the features of the claims.

It is elementary that, even in obviousness rejection, all of the claim limitations must be taught or suggested by the prior art as applied. *CFMT Inc. v. Yieldup International Corp.*, 68 USPQ2d 1940, 1947 (Fed. Cir. 2003).

The sole independent claim, claim 23, now recites a producing composition comprising, *inter alia*, a continuous thermoplastic matrix and a discontinuous phase comprising at least one impact modifier, said discontinuous phase containing at least one electrically conductive filler, wherein the composition is "free of polyphenylene ether" (emphasis added). Miyoshi et al. fails to teach or suggest the claimed composition, in that the resin composition of Miyoshi et al. invariably includes a polyphenylene ether.

Furthermore, Applicants submit herewith as Exhibit C an excerpt taken from Gächter at al., "Plastic Additives," 4th edition, as relating to the general knowledge of the prior art concerning the field of conductive thermoplastic polyamide. This excerpt demonstrates three points:

(a) A finely divided form of the conductive filler and optimum dispersion are desirable for obtaining the desired conductivity (last paragraph of page 762). This means that the conductive filler is preferably well dispersed within the entire plastic matrix in order to obtain the sought and suitable conductivity.

(b) Crystallinity and degree of orientation of the plastics have a significant influence on the conductivity (first paragraph of page 763). Thus, a result obtained

for a specific plastic matrix cannot be expected in another plastic matrix having not the same crystallinity and orientation of phases.

(c) Conductive fillers lead to a decrease in the mechanical properties of the plastic matrix (next to last paragraph of page 763).

The reference as applied fails to teach or suggest the claimed method of introducing conductive fillers into polyamide. Miyoshi et al. is directed to an electro conductive composition comprising a polyamide, a polyphenylene ether, an impact modifier and an electro conductive filler wherein not less than 50 % of all the filler are preliminary compounded with impact modifier and polyphenylene ether. The reference seeks to control the coefficient of linear expansion (see example 1 versus comparative example 1 in Table 1) while maintaining the same electro conductive ability (VR in table 1). However, the document is focused on blends of polyamide plus polyphenylene ether in order to obtain specific properties. The specific use of polyamide and elastomeric impact modifiers is however not mentioned as such. As mentioned in the above-cited "Plastic Additives Handbook," a result obtained for a specific plastic matrix cannot be expected in another plastic matrix having not the same crystallinity and orientation of phases. Accordingly, it is doubtful that one of ordinary skill in the art would have predicted success in modifying the reference to achieve the claimed invention. Moreover, there is no incitation in the prior art to avoid polyphenylene ether as in the present invention as claimed.

Moreover, evidence of nonobviousness exists in Table 5 of the present specification, which shows beneficial effects (namely 581% augmentation of elongation at break, 262% augmentation of notched Charpy impact, and 183 %

augmentation of notched Izod impact) that could not be predictable for a person skilled in the art as represented by Myoshi et al.

Evidence of unobvious or unexpected advantageous properties, such as superiority in a property the claimed compound shares with the prior art, can rebut *prima facie* obviousness. MPEP 716.02(a).II. The PTO must consider comparative data in the specification in determining whether the claimed invention is patentable. *In re Soni*, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995).

It is submitted that a person skilled in the art seeking to obtain a polyamide conductive composition providing good mechanical properties as well as good suitability for painting by an electrostatic technique would not be urged to use teaching of Myoshi et al., which is only focused on alloy of polyphenylene ether and polyamide, and which only demonstrates a certain interest for a low coefficient of linear expansion.

Separate Patentability of Claim 30

By depending from claim 23, it is respectfully submitted that claim 30 is patentable for all the reasons provided above.

Furthermore, it is respectfully submitted that the art teaches away from modifying Myoshi et al. to obtain the subject matter of claim 30. As noted above, conductive fillers lead to a decrease in mechanical properties of the plastic matrix Gächter at al., "Plastic Additives," next to last paragraph of p. 763. Furthermore, Myoshi et al. discloses no more than 5 parts by weight of electrically conductive filler, and notes that when the amount is over 5 parts by weight, fluidity deteriorates. ¶[0114]. Accordingly, one of ordinary skill in the art would be lead away from

"adding an amount of electrically conductive filler sufficient to constitute 5% to 40% by weight relative to the total weight of the composition" as recited in claim 30.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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